

REMARKS

Claims 1 – 2 are presented for reconsideration and further examination in view of the following remarks.

In the outstanding Office Action, the Examiner rejected claim 2 under 35 U.S.C. §112 as being indefinite for failing to point out and distinctly claim the subject matter which Applicant regards as the invention, and rejected claims 1 and 2 under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art and in view of U.S. Patent No. 6,181,436 to Kurachi (hereinafter referred to as "Kurachi").

By this Response, the rejections to claims 1 and 2 are respectfully traversed.

Rejection Under 35 U.S.C. §112

The Examiner rejected claim 2 as being indefinite for failing to point out and distinctly claim the subject matter which Applicant regards as the invention

Response

By this Response, Applicant respectfully traverses the Examiner's rejection.

Claim 2 recites “[a] printer driver, provided at a host computer while said host computer is connected to a stencil printing machine through communications, for setting items of various printing conditions for said stencil printing machine, wherein the various setting items for said printing conditions are displayed; if a watermark print item is selected on the setting items, a selection screen of a secret operation item for allowing said stencil printing machine to execute a secret keeping operation for print data secret is displayed; the items are made selectable; if the printer driver determines that said *secret operation item* is selected, the printer driver

automatically selects a *secret keeping operation* for print data; and information on the selected items are transmitted, together with the print data, to the stencil printing machine.” (Present Application, claim 2, emphasis added)

The Examiner states that it is unclear if the “secret operation item” and the “secret keeping operation” are two distinct features. The “secret operation item” is a selectable element (Specification, Page 3, Line 19) displayed on the selection screen of a printer driver (*id.*; also, claim 2). In contrast, the “secret keeping operation” is the operation that the printer executes to keep print data secret (Specification, Page 3, lines 5-6, 17-18); this can include, but is not limited to, the operation for stencil removal described in the specification (First Embodiment, page 7, lines 2-23; Background of the Invention, page 2, lines 9-18). Thus the secret operation item, as a selectable element of the printer driver, is distinct from the secret keeping operation, as an operation executed by the printer.

As these distinct features are separately supported in the Specification, Applicant respectfully traverses the Examiner’s statement that the features cited in claim 2 are unclear. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the outstanding rejection.

Rejections Under 35 U.S.C. §103(a)

The Examiner rejected claims 1 – 2 as being unpatentable over Applicant’s admitted prior art in view of Kurachi.

Response

By this Response, Applicant respectfully traverses the Examiner’s rejection.

Reconsideration and withdrawal of the rejection is requested since not all of the features of the claims are disclosed, taught, or suggested by the prior art.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Claim 1 recites “[a] printer driver” wherein, *inter alia*, “if the printer driver determines that a watermark print item is selected on the setting items, the printer driver automatically selects a secret operation item for allowing said stencil printing machine to execute a secret keeping operation *for print data*.” (Present Application, claim 1, Emphasis Added).

Claim 2 recites “[a] A printer driver” wherein, *inter alia*, “if a watermark print item is selected on the setting items, a selection screen of a secret operation item for allowing said stencil printing machine to execute a secret keeping operation *for print data* secret is displayed; the items are made selectable; “ and “if the printer driver determines that said secret operation item is selected, the printer driver automatically selects a secret keeping operation *for print data*.” (Present Application, claim 2, emphasis added).

The Examiner acknowledges that the Applicant’s admitted prior art does not teach the feature of incorporating a secret operation setting into the printer driver, and moreover does not teach the feature of automatic selection of the secret operation setting if the printer driver determines that a watermark print is selected. The Examiner cites Kurachi in attempting to cure the deficiency of the Applicant’s admitted prior art.

Kurachi is drawn to a printer driver (Kurachi, column 7, lines 59-60, as cited by the

Examiner) which realizes the function of a secret operations setting, wherein when “secret setting information...is sent from one of the client apparatuses to the printing apparatus, the print job information sending device of the printing apparatus does not send the print job information to other client apparatus” (Kurachi, column 5, lines 4-10, as cited by Examiner). This “print job information” is composed of “management information of the print job and a rough image correlated with the print data corresponding to the Print job” (Kurachi, Summary of the Invention, Column 2 lines 29-31).

As such, Kurachi fails to disclose, teach, or suggest a printer driver that can select a *secret keeping operation for print data* as disclosed in claims 1 and 2. In contrast, Kurachi teaches printer driver which realizes a secret keeping operation for “print job information.” Kurachi’s instructions for secret-keeping are sent to what Kurachi calls a “print job information device” (which Kurachi distinguishes from both a print data device and an output device; see Kurachi, claim 7). Further, the print job information device is not instructed to keep secret the data which the device actually prints, which Kurachi refers to as “print data”; rather, what is kept secret is the “print job information” as described above. “[W]hen the print data receiving device receives the secret setting information...the print job information sending device does not send the print job information to the other client apparatuses.” (Kurachi, claim 7, column 26, lines 35-46, as cited by the Examiner).

Arguendo, even if the “printing apparatus” in Kurachi’s patent were a stencil printer of the type addressed in the Present Application, secret-keeping instructions sent by the driver of Kurachi could not initiate the secret-keeping operations to which the Present Application is directed, such as that disclosed in the first embodiment: “soon after the completion of printing, the used stencil sheet is removed from the print drum to make printing impossible and the

removed stencil sheet is disposed of in a stencil disposal box.” (Present Application, Specification, Page 7, lines 13-16). The removal of a stencil sheet keeps the “print data” secret, while the secret keeping operation of Kurachi, as discussed above, is performed on “print job information” such as “management information of the print job and a rough image correlated with the print data corresponding to the Print job.” As Kurachi’s printer driver only sends instructions for keeping print job information secret, it can not be read to include instructions for keeping print data secret.

Further, in claim 1, the secret-keeping step in the Present Application is performed automatically when a “watermark print item is selected.” (claim 1). The Examiner states that “watermark print is widely known and available in the art” (Office Action, Page 3), and that “setting defaults for automatically selecting certain features/functions are well known and widely available in the art.” (*id.*) The Examiner is improperly taking Official Notice that the prior art teaches printer drivers which conditionally select secret operation items when other print items (such as watermark print items) are selected. “If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” *MPEP 8th ed.* §2144.03(B) (*construing In re Soli*, 317 F.2d 941, 946 (CCPA 1963) and *In re Chevenard*, 139 F.2d 711, 713 (CCPA 1943). Showing that “watermark print is widely known” is irrelevant to proving if it is widely known that printer drivers can conditionally select *secret operation items* when other print items (such as watermark print items) are selected. The Examiner must show a basis in the prior art for the knowledge that printer drivers can conditionally select such secret operation items when other print items are selected.

As the combination of the Applicant's admitted prior art and Kurachi fails to disclose, teach, or suggest a printer driver which activates a secret keeping operation *for print data* (claims 1 and 2), and moreover fails to disclose, teach, or suggest the *automatic selection of a secret keeping operation* for print data if the printer driver determines that a watermark print is selected (claim 1), Applicant respectfully requests that the Examiner reconsider and withdraw the outstanding rejections under 35 U.S.C. §103(a).

CONCLUSION

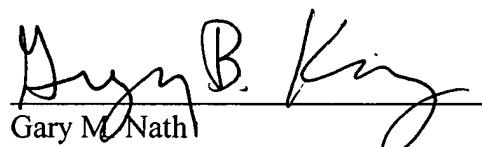
In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,
NATH & ASSOCIATES PLLC

Date: January 27, 2006
NATH & ASSOCIATES PLLC
112 South West Street
Alexandria, VA 22314
(703) 548-6284

By:



Gary M. Nath
Registration No. 26,965
Gregory B. Kang
Registration No. 45,273
Teresa M. Arroyo
Registration No. 50,015
Customer No. 20529